



1654  
18w

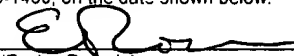
HUBR 1159 (10016584)

**CERTIFICATE OF MAILING:** I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail, in an envelope addressed to: Commissioner for Patents, P.O. BOX 1450, Alexandria VA 22313-1450, on the date shown below.

Dated:

2/2/05

Signature:

  
(Evelyn Rosario)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
Josef BURG et al.

Application No.: 09/555,950

Group Art Unit: 1654

Filed: August 17, 2000

Examiner: Maury A. Audet

For: ERYTHROPOIETIN WITH SPECIFIC  
ACTIVITY

**RESPONSE TO OFFICE ACTION**  
**(37 CFR § 1.111)**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313

Dear Sir:

This is submitted in response to the office action of September 9, 2004. A two month extension of time is required, and a petition therefore, with fee, accompanies this response.

Claims 88-99, 101, 103 and 104 are pending. All of these claims have been rejected over 35 USC §102(b), (e) and 35 USC §103 in view of Watson, et al., Glycobiology 4(2): 227-37 (1994); Takeuchi, et al., Proc. Natl. Acad. Sci. USA 86: 7810-7822 (1984); Blumen, et al., U.S. Patent No. 5,459,031; Akamatsu, et al., U.S. Patent No. 4,745,099; Strickland, et al., U.S. Patent No. 5,856,298.

The examiner appears to accept that none of these references teach the recombinant production of EPO in human cells. Yet, the examiner posits that EPO

produced in CHO cells – which is what each and every reference teaches – must inherently teach what is claimed.

First, inherency is a basis for an anticipation reference if and only if the reference teaches that what is claimed is the inevitable and necessary result of what is taught in the prior art. While the references teach production of EPO, there is no showing or suggestion of at least 4.3 N acetyl lactosamine units per N-linked carbohydrate, or an average of 13.0 N-acetyl lactosamine units, as referred to total N-glycosylation, nor of carbohydrates with N-acetyl lactosamine units of at least 10%.

Evidence provided in the specification clearly and unequivocally establishes that human and non-human cells DO NOT produce the same EPO. Please see page 51 of the specification table 4, comparing three non-human samples (CHO) with five human samples (HeLa).

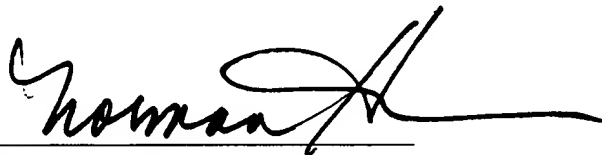
Note, especially, that if one were to compare CHO1 with HeLa1, where the degree of tetrantennarity and NaLa units are in fact, essentially the same. For the EPO produced in human cells, a repeat percentage of 18 was sufficient for activity of 220 ku/mg. CHO1 required 39.6 for 248 ku/mg. The difference of 28 ku/mg is not explainable by repeats only. One must conclude that there is a fundamental difference between EPO produced in human and non-human cells.

Indeed, when one compares CHO2/HeLa2 or HeLa3, or CHO3/HeLa4, the parameters differ by about 15%. When repeat percentages are compared, however, CHO2 shows 51% as compared to 16.5 and 14%, (HeLa 2 and 3), while CHO3 shows 42.6%, as Compared to 12.2% (HeLa4) -- a variance of 220-360%, for essentially equal activity.

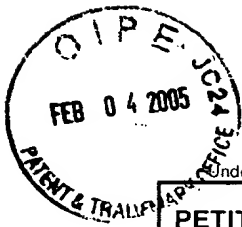
The facts show that the molecules are NOT the same, and there is absolutely no suggestion that one could routinely and obviously secure molecules from human cells, with the recited properties.

In view of this, it is asserted that the claimed subject matter cannot be deemed anticipated or obvious in view of the cited references and be holding to that end, by way of a notice of allowance, is requested.

Respectfully submitted,

By 

Norman D. Hanson  
Registration No.: 30,946  
FULBRIGHT & JAWORSKI L.L.P.  
666 Fifth Avenue  
New York, New York 10103  
(212) 318-3000  
(212) 318-3400 (Fax)  
Attorneys for Applicant



<b>PETITION FOR EXTENSION OF TIME UNDER 37 CFR 1.136(a)</b>		<b>Docket No. (Optional)</b> HUBR 1159 (10016584)											
In re Application of <b>BURG, ET AL</b>													
Application Number 09/555,950		Filed AUGUST 17, 2000											
For: <b>ERYTHROPOIETIN WITH SPECIFIC ACTIVITY</b>													
Art Unit 1654		Examiner MAURY A. AUDET											
<p>This is a request under the provisions of 37 CFR 1.136(a) to extend the period for filing a reply in the above identified application.</p> <p>The requested extension and appropriate non-small-entity fee are as follows (check time period desired):</p> <table><tr><td><input type="checkbox"/> One month (37 CFR 1.17(a)(1))</td><td>\$</td></tr><tr><td><input checked="" type="checkbox"/> Two months (37 CFR 1.17(a)(2))</td><td>\$ 450.00</td></tr><tr><td><input type="checkbox"/> Three months (37 CFR 1.17(a)(3))</td><td>\$</td></tr><tr><td><input type="checkbox"/> Four months (37 CFR 1.17(a)(4))</td><td>\$</td></tr><tr><td><input type="checkbox"/> Five months (37 CFR 1.17(a)(5))</td><td>\$</td></tr></table> <p><input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27. Therefore, the fee amount shown above is reduced by one-half, and the resulting fee is: \$</p> <p><input checked="" type="checkbox"/> A check in the amount of the fee is enclosed.</p> <p><input type="checkbox"/> Payment by credit card. Form PTO-2038 is attached.</p> <p><input type="checkbox"/> The Director has already been authorized to charge fees in this application to a Deposit Account.</p> <p><input checked="" type="checkbox"/> The Director is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number <u>50-0624</u>.</p> <p>I have enclosed a duplicate copy of this sheet.</p> <p>I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96). <input type="checkbox"/> attorney or agent of record. Registration Number _____ <input checked="" type="checkbox"/> attorney or agent under 37 CFR 1.34(a). Registration number if acting under 37 CFR 1.34(a) <u>30,946</u></p> <p><u>2/2/05</u> Date</p> <p><u>(212) 318-3168</u> Telephone Number</p> <p><u>Norman D. Hanson</u> Signature Typed or printed name</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below</p> <p><input type="checkbox"/> Total of _____ forms are submitted.</p>				<input type="checkbox"/> One month (37 CFR 1.17(a)(1))	\$	<input checked="" type="checkbox"/> Two months (37 CFR 1.17(a)(2))	\$ 450.00	<input type="checkbox"/> Three months (37 CFR 1.17(a)(3))	\$	<input type="checkbox"/> Four months (37 CFR 1.17(a)(4))	\$	<input type="checkbox"/> Five months (37 CFR 1.17(a)(5))	\$
<input type="checkbox"/> One month (37 CFR 1.17(a)(1))	\$												
<input checked="" type="checkbox"/> Two months (37 CFR 1.17(a)(2))	\$ 450.00												
<input type="checkbox"/> Three months (37 CFR 1.17(a)(3))	\$												
<input type="checkbox"/> Four months (37 CFR 1.17(a)(4))	\$												
<input type="checkbox"/> Five months (37 CFR 1.17(a)(5))	\$												

02/07/2005 CNGUYEN 00000028 09555950

01 FC:1252

450.00 OP